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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/299,068	04/23/1999	WILL F. WILLIAMSON	25932-5	2791

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/25/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/299068

Applicant(s)

WILLIAMSON et al

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11-13-01 and 02-26-02

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-36

is/are pending in the application.

Of the above claim(s)

is/are withdrawn from consideration.

☐ Claim(s)

is/are allowed.

☒ Claim(s) 1-36

is/are rejected.

☐ Claim(s)

is/are objected to.

☐ Claim(s)

are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The request filed on November 13, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53 (d) based on Parent Application 09/299,068 is acceptable and a CPA has been established. An action on the CPA follows.

key The amendment filed November 13, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the deletion at page 7, lines 25-32 and the insertion of the new paragraph at the same location of the instant application. New matter also cover the originally disclosure which is present at the time of filing of the instant application which is deleted during the prosecution of the instant application. The filing of a C-I-P application of instant application is used for the purpose to add or delete disclosure from the parent application. Thus the newly filed amendment at page 7, lines 25-32 of the instant application is considered as new matter.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

✓ Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of "sorbate" in line 4 of claim 10 would appear to constitute new matter. Such a compound does not appear to be supported by the disclosure as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2, 12, 21 and 29 are indefinite and confusing for the phrase "(selected...trimethyloethane)," because it is unclear if a comma "," should be inserted before "cyclopentene". It is suggested that the parenthesis "(" ") should be deleted for clarity. Claims 3, 13, 22 and 30 are indefinite in that the said claims duplicate claims 1, 11, 20 and 28 and therefore do not further limit previous claims 1, 11, 20 and 28, respectively. It is suggested that each of claims 3, 13, 22 and 30 should be canceled. Claims 4, 14, 22 and 31 are indefinite and confusing for the species "tetrahydrophthalic anhydride, tetrahydrophthalic acid, acrylic acid, acrylic anhydride and C₁₋₁₀ alkyl, C₂-C₁₀ alkenyl, or C₁₋₁₀ derivatives of the foregoing acids and anhydrides, and combination thereof because they are not chemically consistent with the description of the second moiety as recited in independent claims 1, 13, 22 and 28. Each of the independent claims require the second moiety to be a conjugated diene, -C=C-C=C-, with a carboxylic acid or anhydride functional group and the species of claims 4, 14, 22, species fails to satisfy the requirement of claims 1, 13, 22 and 28. Claim 10 is indefinite for the use of "sorbate" in line 4 which appear to be chemically inconsistent with the description of the second moiety as

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recited in independent claim 1 for a "sorbic acid" or a "sorbic anhydride". Claim 36 is indefinite for the use of "maleic anhydride" in lines 11-13 because it is not chemically consistent with the description of the second moiety as recited in lines 7-8 of the previous part of the claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-19 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaza et al (Kaza) 4,574,057 in view of Urushibata et al 5,304,316 and Lindemann 3,322,703.

Kaza teaches and discloses reactions and products produced by said reactions comprising a first moiety, (a) and/or (b), col. 1, line 48-56 and col. 3, line 37 to col.4 line 32 land 57 to col. 5, line 55; a second moiety, (c), col.6, line 36 to col. 7, line 20; and a third moiety, (e), col.7, line 63 to col. 10, line 20, col. 4, lines 33-38 and Table I and Example I wherein applicants first, second

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and third moieties are rendered obvious by patentee moieties (a) and/or(b), (c) and (e). Kaza does not explicitly teach the instant claim 10. Little patentable weight is given to intended use “antiwear” preamble of instant claim 10 because normally it is given little or no patentable weight unless such a preamble were factually shown to be a structural limitation as elucidated in MPEP 211.02.

It is the examiner’s position of record that it would be obvious to the artisan in the art to select POE/POP trimethyltrioleate (TMPO) as the first moiety, and phthalic anhydride as the second moiety, and sorbitol of Urushibata, cols. 5 and 6 as the third moiety of Kaza to render the claims, especially claim 10 obvious. It is the examiner’s position that the friction reducing properties (anti-wear properties) of Urushibata and Kaza compounds and processes are obvious because a newly disclosed property does not necessarily mean the product is unobvious, since this property may be inherent in the prior art. In re Best 195 USPQ 430; In re Swinehart 169 USPQ 226. When the prior art and applicant both describe processes which are indistinguishable, then the products may also be assumed to be inherently indistinguishable. In re Myers 159 USPQ 339 (1968). The burden is shifted to Applicants to show product differences in product by process claims. In re Best 195 USPQ 430 (CCPA 1977); In re Brown 173 USPQ 685; In re Fessman 180 USPQ 324.

The Lemann teachings are incorporated in Urushibata at column 6 provide the teachings and motivation for using an acid catalyst in Urushibata esterification process, not column 10, lines 6-7. It is the examiner’s position that Urushibata’s generic disclosure renders the Applicants’

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claimed species prima facie obvious. Urushibata further provides the motivation to substitute one polyhydroxy for another, one acid for another and one unsaturated synthetic dieneophilic base oil for another. A generic disclosure renders a claims species prima facie obvious. Ex parte George 21 USPQ 2d 1057, 1060 (BPAI 1991); In re Woodruff 16 USPQ 2d; Merck & CO. v. Biocraft Lab. INC. 10 USPQ 2d 1843 (FED. Cir 1983); In re Susi 169 USPQ 423 (CCPA 1971).

Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaza et al (Kaza) 4,574,057 in view of Urushibata et al 5,304,316 and Lindemann 3,322,703 as applied to claims 1-19 above, and further in view of Zehler 4,601,840.

Kaza and Urushibata are silent to disclose or suggest their reactive products as an additive for an anti-friction (anti-wear) supplement composition and as a friction (anti-wear) modifier in a crank case formulation comprising a phosphorous additive, optionally an EP additive, a VI, an antioxidant, pour depressant, a dispersant, a detergent and a base oil carrier.

Zehler teaches and discloses a lubricant composition comprising a base oil carrier and other conventional additives and a non-phosphorous friction modifier compound when a technical grade PE is reacted with an acid mixture. Note abstract, column 5, line 39 to column 6, lines 1-52 column 9 line 61 to col. 9, line 64 and Example 8 of column 15. For the usually percentage of the conventional additives, note column 13 lines 40-48 rendering the claimed percentage of the conventional additives obvious. Zehler provides the motivation for using Kaza and Urushibata additive reaction product in a lubricant composition wherein their reaction product is rendered obvious by Kaza and Urushibata et al product modified with the secondary references.

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The prior art cited but not relied upon further teaches reaction products and processes comprising components of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 305-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:0 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for non final actions, and 7-3-872-9311 for finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Examiner Medley/ng

April 24, 2002


MARGARET MEDLEY
PRIMARY EXAMINER